

REMARKS

Claims 1-4, 6-23, 25-39 are pending in the application, with claims 1, 20, and 39 being independent. Reconsideration and allowance of Applicant's claims are respectfully requested in light of the following remarks.

Claims 1-11, 13-30 and 32-39 are rejected under 35 USC. §102(e) as anticipated by U.S. Patent No. 7,133,898 (Malik). Defendant claims 12 and 31 are rejected under 35 USC. §103(a) over Malik in view of U.S. Patent Application No US 2003/0110212 (Lewis). Applicant respectfully requests that these rejections be withdrawn because Malik does not describe or suggest all of the limitations of independent claims 1, 20, and 39, as amended. For instance, Malik does not describe or suggest "adding the person to the maintained list when the person is determined to be associated with the user based, at least in part, on positive user actions related to e-mail communications with the person," as recited in claim 1.

Malik describes a system for sorting and presenting e-mails in classifications, for example, classifying emails as from personal contacts, from vendors, or from unknown sources. *See, Abstract; col. 6:18 - 23.* Malik uses a vendor list to identify e-mails from vendors and uses a contact list to identify e-mails from personal contacts of the user, and. When creating the vendor's list, Malik adds a new vendor to the list by user explicitly registering vendor's e-mail addresses and related information in a server database. *col. 6:30 - col. 7:10.* Thus, in Malik, adding a vendor to the list is not performed based on positive user actions related to e-mail communications with the person, as recited in claim 1.

Further, Malik's contact list is a "user's electronics contact list or rolodex." *See, e.g., col. 7 lines 19 -21.* Malik is silent on how this electronics contact list is created or uploaded, and simply assumes the existence of such personal contact list.

Accordingly, in both cases, Malik does not suggest or describe the feature of adding a person to the maintained list based on positive user actions related to email communications with the person, as recited in independent claims 1.

Applicant submits that Lewis does not cure these deficiencies of Malik. Accordingly, Malik and Lewis, either alone or in combination, fail to suggest or describe all of the features of

independent claim 1. Similarly, independent claim 20 recites "determine that a person is associated with the user based, at least in part, on positive user actions related to e-mail communications with the person; and add the person to the maintained list when the person is determined to be associated with the user based, at least in part, on positive user actions related to e-mail communications with the person." Independent claim 39 recites "means for determining that a person is associated with the user based, at least in part, on positive user actions related to e-mail communications with the person; and means for adding the person to the maintained list when the person is determined to be associated with the user based, at least in part, on positive user actions related to e-mail communications with the person." Applicant submits that Malik and Lewis do not describe or suggest these features of claim 20 and 39 at last for the reasons described with respect to claim 1.

Therefore, Applicant submits that independent claims 1, 21, 39 and those claims that depend from them, are allowable over Malik and Lewis for at least the reasons above.

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Office Action's characterizations of the art, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Applicant reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

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